

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

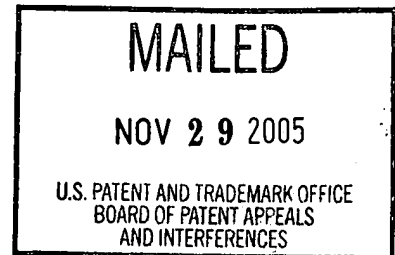
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte Kelly Gravelle

Appeal No. 2005-2058
Application No. 09/864,443

ON BRIEF



Before Thomas, Hairston, and Jerry Smith, Administrative Patent Judges.

Jerry Smith, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-31, which constitute all the claims pending in this application.

The disclosed invention pertains to an ordering system and method for placing orders for items and for picking up the ordered items at a specified location. A particular feature of the invention is that the order is correlated with a wireless tag identification number, and payment for the items is made against

an account associated with the wireless tag when the items are picked up at the specified location.

Representative claim 1 is reproduced as follows:

1. An ordering method comprising:

placing an order for an item by specifying the item and a location for picking up the item, and by providing an identification;

relaying the order to a validating processor;

identifying a wireless tag identification number corresponding to the identification provided;

authorizing payment of the order from an account associated with the wireless tag; and

reading the tag identification number from the wireless tag when the tag is located in a vicinity of the pick up location.

The examiner relies on the following references:

Hall et al. (Hall) 6,026,375 Feb. 15, 2000

Kuykendall, L., "E-Payment Reaches the Happy Meal Customer,"
American Banker, vol. 166, issue 51, May 15, 2001, pages 8-10.

Claims 1-31 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness the examiner offers Hall in view of Kuykendall.

Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in the claims on appeal. Accordingly, we affirm.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to

modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision.

Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR § 41.37(c)(1)(vii)(2004)].

In the rejection as formulated by the examiner, the examiner essentially finds that Hall teaches the claimed invention except that Hall does not teach the features related to the use of a wireless tag. The examiner cites Kuykendall as teaching the use of a wireless tag to pay for items at a fast food restaurant. The examiner finds that it would have been obvious to the artisan to include the wireless tags of Kuykendall in the Hall ordering system [answer, page 4].

With respect to claims 1-5, 8-15, 17-20 and 23-30, which stand or fall together as a single group [brief, page 4], appellant argues that there is no basis for combining the teachings of Hall and Kuykendall because they point in opposite directions in terms of complexity, and therefore, combining the teachings defeats the purpose of one or the other. Appellant notes that the use of a transponder in Hall would have been superfluous because Hall already allows for fast payment of the ordered items. Appellant argues that the combined teachings still would not suggest the step of identifying a wireless tag

number when placing an order because such information is not needed until the item is picked up [brief, pages 4-11].

The examiner responds that there is motivation to combine the two references because Hall recognizes the importance of incorporating new technology into its ordering system. The examiner asserts that the claimed invention is suggested when the wireless tag payment method as taught by Kuykendall is used as the payment method in Hall [answer, pages 4-6].

Appellant responds that the examiner has failed to address the fact that the references teach away from their combination [reply brief, pages 1-2].

We will sustain the examiner's rejection with respect to claims 1-5, 8-15, 17-20 and 23-30. Appellant's argument that the two references cannot be combined because they teach away from each other is not convincing. The fact that Hall and Kuykendall highlight features of different complexity does not make these teachings unrelated. On the contrary, both references relate to the manner in which items can be charged to a particular account when they are picked up. Hall makes it clear that in an ordering system of the type claimed by appellant, it is necessary that the customer provide identifying information at the time of placing the order [column 2, lines 51-52 and 64-65]. Hall also teaches

that a database contains information about the customers preferred method of payment, such as debit card, credit card, smart card, or cash [column 8, lines 39-41]. Thus, the system of Hall identifies the customer at the time the order is placed and stores information regarding the customer's preferred method of payment. Kuykendall teaches that some customers prefer to pay for ordered items by using a wireless identification tag. Thus, the artisan would have found it obvious to add the wireless tag identifications to the database of Hall, which stores the preferred methods of payment, so that the customers with wireless tags could use the associated accounts to pay for the items that are picked up. Once the wireless tag information is added to the database of Hall as the preferred method of payment, the person placing the order would still have to identify his wireless tag as the preferred method of payment so that the appropriate account can be charged for the items. In summary, since Kuykendall teaches that some customers prefer to pay for items using an account associated with a wireless tag, and since Hall teaches an ordering system in which the preferred method of payment is identified at the time that an order is placed, it would have been obvious to the artisan to use the wireless tag identification of Kuykendall in the ordering system of Hall.

With respect to claims 6 and 21, which stand or fall together as a single group [brief, page 4], appellant argues that the applied prior art fails to teach providing a telephone number as the form of identification [brief, pages 11-12]. The examiner responds that Hall teaches providing a telephone number to the system [answer, page 6]. Appellant responds that the applied prior art does not teach identifying a wireless tag based on a telephone number as claimed [reply brief, pages 2-3].

We will sustain the rejection of claims 6 and 21. As noted above with respect to claim 1, Hall teaches providing user identification at the time that an order is placed. As also noted above, providing identification related to a wireless tag would have been obvious to the artisan for reasons discussed above. Since any form of identification would be acceptable, and since telephone numbers are a well known way in which individuals are identified, we find that it would have been obvious to the artisan to identify wireless tags by associating them with telephone numbers.

With respect to claims 7 and 22, which stand or fall together as a single group [brief, page 4], appellant argues that the applied prior art fails to teach providing a personal identification number as the form of identification [brief, pages

12-13]. The examiner responds that the term personal identification number is broad enough to read on the credit card number of Hall [answer, pages 6-7]. Appellant responds that it is not reasonable to read the claimed personal identification number on a credit card number [reply brief, pages 3-4].

We will sustain the rejection of claims 7 and 22. As noted above with respect to claim 1, Hall teaches providing user identification at the time that an order is placed. As also noted above, providing identification related to a wireless tag would have been obvious to the artisan for reasons discussed above. Since any form of identification would be acceptable, and since personal identification numbers are a well known way in which individuals are identified, we find that it would have been obvious to the artisan to identify wireless tags by associating them with personal identification numbers.

With respect to claims 16 and 31, which stand or fall together as a single group [brief, page 4], appellant argues that the applied prior art fails to teach correlating read tag numbers with a record of validated tags [brief, pages 13-14]. The examiner responds that each time a car with an "EZ pass" is read it is correlated to the user who is billed [answer, page 7].

Appellant responds that the claimed correlation is still not performed as part of a means or step for identifying items [reply brief, page 4].

We will sustain the examiner's rejection of claims 16 and 31. In order for the system of Hall to give the correct items to a given customer, it is necessary for the system to determine or correlate which order (validated tag) corresponds to read tag information at the time that the items are picked up.

In summary, we have sustained the examiner's rejection of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1-31 is affirmed.

AFFIRMED

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12

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